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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,721	02/04/2004	Gerhard Gumpol Tsberger	ZAHFRI P600US	4958
20210	7590	09/20/2005	EXAMINER	
DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151			LEWIS, TISHA D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/771,721

Applicant(s)

TSBERGER ET AL.

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) 32,33,36 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-31,34,35,37,38 and 40-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

The following is a first action on the merits of application serial no. 10/771,721 filed on February 4, 2004.

#### ***Election/Restrictions***

Claims 32, 33, 36 and 39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 29, 2005.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

The information disclosure statements filed on February 4 and March 19, 2004 have been considered.

#### ***Claim Objections***

Claim 35 is objected to because of the following informalities:

--gear- should be inserted between "output and wheel". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The word "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-30, 35, 37, 38, 40-44, 48, 51 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher ('188). Fisher discloses a countershaft transmission having six speeds, a selector clutch (18, 22) connected with an engine shaft (10) and an input shaft (20, 24), two countershafts (62, 92) having rotatably supported idler wheels (64, 66, 68, 70, 94, 96, 98), fixed wheels (54, 56, 60, 58) non-rotatably supported on the input shafts, coupling devices (72, 82, 100, 108) non-rotatable and axially moveable on the countershafts by setting devices, one output gear wheel (120, 122) fastened on the countershaft in tooth contact with one toothing (via 124) on a differential, two fixed wheels (60, 56) are in tooth contact with each of two idler gears (68, 96, 66, 94). The first idler wheel (96) of the sixth gear and the second idler wheel (94) of the fifth gear are situated upon the second countershaft (92) while the third idler wheel (68) of the fourth gear and the fourth idler wheel (62) of the third

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gear are supported on the first countershaft (62). The first idler wheel (98) of the second gear and the second idler wheel (70) of the reverse gear are situated on different countershafts and driven by a common fixed wheel (58). The output gear wheels (120, 122) are situated on the ends of the countershafts pointing to the clutch. The fourth gear (68) and the reverse gear (70) having a common coupling (82) are alternatively non-rotatably connectable with the first countershaft (62) and the second gear (98) and the sixth gear (96) having a common coupling (108) are alternatively non-rotatably connectable with the second countershaft (92). The first gear (64) and the third gear (66) having a common coupling (72) are alternatively non-rotatably connectable with the first countershaft and the fifth gear (94) having a coupling (100) is connectable with the second countershaft. The coupling devices are designed as shifting sets having sliding sleeves axially moveable upon the countershafts. The first gear is situated in the front of the housing and the reverse and second gear are situated in a center of the housing. The clutch (18, 22) is designed as powershift multi-disc clutch. The gear wheel (58) can be used to drive auxiliaries. The differential transmission is designed as a power divider transmission.

Claims 28, 34, 40-44, 51 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Heinzl et al ('407). Heinzl et al discloses a transmission having six speeds, a selector clutch (K1, K2) connected with an engine shaft (10) and an input shaft (12, 14), two countershafts (16, 18) having rotatably supported idler wheels (42, 90, 46, 92, 50, 98, 54, 100), fixed wheels (34, 60, 58, 38, 62, 64) non-rotatably supported on the input shafts, coupling devices (S1-S4) non-rotatable and axially

moveable on the countershafts by setting devices, one output gear wheel (94, 102) fastened on the countershaft in tooth contact with one toothing (via 96) on a differential (20), two fixed wheels (34, 38) are in tooth contact with each of two idler gears (42, 50, 46, 54). The two countershafts have different distances from the input shaft (column 5, lines 26-27) and the output wheels output different ratios according to the selected ratio. The coupling devices are designed as shifting sets having sliding sleeves axially moveable upon the countershafts. The first gear is situated in the front of the housing and the reverse and second gear are situated in a center of the housing. The clutch (K1, K2) is designed as powershift multi-disc clutch. The differential transmission is designed as a power divider transmission.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher and Heinzl et al. Fisher and Heinzl et al disclose a sequence for a gear arrangement of the transmission, but not the claimed sequence.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the gear arrangement of Fisher and Heinzl et al according to the claimed sequence because re-arranging the gear positions would not modify the operation of the transmissions.

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher and Heinzl et al in view of Kobayashi ('168). Fisher and Heinzl disclose a transmission, but does not disclose a torque converter and a damper.

Kobayashi discloses a transmission having two countershafts for providing at least six speeds and a torque converter with a damper arrangement (Figure 9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Fisher and Heinzl et al with a torque converter to provide a spread between the gear ratios and with a damper to reduce vibration between the engine and transmission in view of Kobayashi.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher and Heinzl et al in view of Hall, III ('705). Fisher and Heinzl disclose a transmission, but does not disclose a brake.

Hall, III discloses a transmission having two countershafts for providing at least six speeds wherein the countershafts are provided with brake mechanisms (74, 76).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Fisher and Heinzl et al with a brake mechanism on the countershafts in view of Hall, III to provide synchronization between the input shaft and output shaft speeds before a gear shift change.

Claims 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher and Heinzl et al in view of Pels et al ('247). Fisher and Heinzl disclose a transmission, but does not disclose an electric generator.

Pels et al discloses a transmission having two countershafts for providing at least six speeds wherein an electric generator (10) is provided on one of the countershafts or the input shaft to be driven from a clutch side.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Fisher and Heinzl et al with an electric generator in view of Pels et al to provide assistance torque to the engine.

Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher and Heinzl et al in view of Smith ('483). Fisher and Heinzl disclose a transmission, but does not disclose the actual arrangement of the setting devices.

Smith discloses a transmission having two countershafts for providing at least six speeds wherein coupling devices are actuated by servo piston-cylinder systems hydraulically (Figures 3a-10).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Fisher and Heinzl et al with servo piston systems to actuate couplings in view of Smith to provide semi-automatic control of transmission.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28-31, 34, 35, 37, 38 and 40-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34, 37-39, 42, 43, 46, 47, 49-52, 55, 57 and 59-66 of copending Application No. 10/771,723. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the co-pending application are encompassed in the limitations of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

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Typed or printed name of person signing this certificate:

\_\_\_\_\_

---

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Ordo ('560), Hosono ('292), Ishihara et al ('832), Hirt ('577), Kim et al ('344), Winckler et al ('293), Henzler et al ('789), Alfredsson ('472), Ebenhoch ('061) and EP 545102A1.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl  
September 15, 2005

  
TISHA LEWIS  
PRIMARY EXAMINER  
AU 3681 9/15/05